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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/817,237 | 03/27/2001 | Takashi Hasegawa | 106145-00013 | 8079 |

7590 06/21/2004

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EXAMINER

JANVIER, JEAN D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3622

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,237

Applicant(s)

HASEGAWA ET AL.

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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Detailed Action

Specification

The title, under 37 CFR 1.72, should be brief, descriptive and technically accurate and should be placed on the top portion of the first page of the specification.

On page 4, line 17, after "lunch box at ..." and just before "convenience ...", two graphical identifiers namely a circle and a triangle have no apparently meaning.

Claim Status

Claims 1-2 are currently pending in the Instant Application.

Claim Objections

Claim 2 is objected to because of the following informalities:

Concerning claim 2, line 2, "informationmeans" should apparently be --information means--.

Further, the claimed invention will be broadly interpreted because of its disclosure.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Scroggie et al. (Scroggie hereinafter), WO 97/23838.

As per claims 1-2, Scroggie teaches an incentive distribution network or system over the Internet wherein a plurality of purchasing incentives and shopping aids are made available for qualified customers through the Internet or via e-mail. A customer (10) of retail stores, logs into the system and then elects to browse among available purchasing offers (18, 22), elects to claim a product rebate or to receive product information. The system merges customer's supplied information (270) with other purchase incentive data (272) and creates a printable graphical image of the purchasing incentive (282) for transmission to the customer. In an alternate embodiment, the purchase incentive is not transmitted directly to the customer. Instead, the terms of the incentive are transmitted electronically to the retail store (310) of fig. 13 designated by customer (10) or located in the customer's **geographical** region, who receives either a token (316) having at least a specific code or a bar code to present at the store or an advisory message used along with other identification to identity the customer at the POS during a redemption process. Further, in yet another embodiment, incentives may be targeted to specific customers based on a customer's purchase history (502) and transmitted to the consumers by e-mail using

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the customers' e-mail addresses stored in a consumer database (506). In other words, notification or indication of the availability of these incentives is transmitted to the customers in the form of Internet messages, for retrieval when the customers or consumers next access a web site associated with the system or check their e-mails. Moreover, the incentive message informs a customer that one or more specific offers are available and can be received at a participating POS when the prerequisite products are purchased. Alternatively, subsequent to receiving an e-mail notification or an indication of an incentive offer, an image of a paper coupon may be transmitted to the customer's computer site and printed for later presentation at pre-selected POS.

In a further embodiment of the invention, incentives may be customized or targeted to a specific customer based on the customer's purchase history (previous purchase) 502 collected at a retailer's store after the sale of one or more products and provided to a product manufacturer or distributor or System Administrator, and wherein the purchase history data comprising at least one product sold at the retailer's and wherein after this customization, by the manufacturer or provider or distributor of the product in conjunction with the retailer, the incentives are transmitted to consumer's computer 510 via electronic mail or e-mail address stored in a consumer database 506 storing customer's registration information or via a personal web page in the computer network established for each consenting consumer, based upon the customer's demographic profile and purchase history, wherein the personal web page is used to display the customized incentives to the user or customer whenever he/she logs into the network subsequent to sending an e-mail notification to the customer inviting him/her to log into the network and visit his personal web page to view and download these customized incentives.

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(See abstract; page 9: 22-30; page 12: 23-25; page 13: 2-3; page 15: line 3-10; page 20: 2-8; page 20:16 to page 21: 30; page 22: 2 to page 23: 22; figs 9 and 11-15).

Conclusion

Although the following references were not officially used in the office action, they were considered as relevant prior art. Applicant is further directed to review these references.

US Patent 6, 321, 208B1 to Barnett discloses an electronic coupon distribution system for issuing targeted coupons to interested and qualified customers over the Internet.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (703) 308-6287). The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (703) 305- 8469.

For information on the status of your case, please call the help desk at (703) 308-1113.

Further, the following fax numbers can be used, if need be, by the Applicant(s):

After Final- 703-872-9327

Before Final -703-872-9326

Non-Official Draft- 703-746-7240

Customer Service- 703-872-9325



JDJ

06/12/04